

REMARKS/ARGUMENTS

Claims 1-65 were previously pending in the application. All claims stand rejected on various grounds. Claims 1, 2, 11-13, 15, 20-22, 24, 36-37, 45, 47, 51, 53, 55, and 60-62 have been cancelled without prejudice. Also, Claims 3, 5, 8, 15-19, 23, 25, 27-29, 31, 33, 38-44, 46, 48, 52, 54, & 56-59 have been amended herein. Accordingly, Claims 3-10, 14-19, 23, 25-35, 38-44, 46, 48-50, 52, 54, 55, 56-59, and 63-65 are now pending in this application. Certain informalities and inconsistencies in the claims have also been corrected. No new matter has been added. Reconsideration and allowance are respectfully requested.

Claim Rejections Under 35 U.S.C. §112:

Claims 1, 13, 14, 20, 31, and 38 were rejected under 35 U.S.C. §112, 1st paragraph, for non-compliance with the written description requirement. Claims 1, 13, and 20 are cancelled making this ground of rejection moot as to those claims. Moreover, the remaining rejected claims (14, 31, & 38) have been amended to remove the objectionable negative limitation language. Accordingly, applicants request that this ground of rejection be withdrawn.

Claim Rejections Under 35 U.S.C. §101:

Claim 13 was rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Claim 13 is cancelled, making this ground of rejection moot. Accordingly, applicants request that this ground of rejection be withdrawn.

Claim Rejections Under 35 U.S.C. §103:

Rejections of Claims 1, 2, 8, 11, 12, 44-51, 13-15, 19-24, 55-65, 28, 31, and 38-43 in view of Logan and Breggin:

Claims 1, 2, 8, 11, 12, 44-51, 13-15, 19-24, 55-65, 28, 31, and 38-43 stand rejected under 35 U.S.C. §103(a) as being anticipated by the U.S. Patent to *Logan* (USPN 6,601,018) (hereinafter *Logan*) in view of the U.S. Patent to *Breggin et al* (USPN 6,560,776)(hereinafter *Breggin*). *Logan* is directed to an invention “for test execution” of software in “the context of an automatic test framework” (e.g., *Logan*, Abstract). In particular, *Logan* is directed to a test procedure that requires that all “tested” programs are executed to confirm that they are operational (e.g., *Logan* at 2: 19-21; 11:65-66: etc.). Moreover, *Logan* requires that tests (test suites) be modified by hand as needed (*Logan* 2: 25-29). Thus, the invention of *Logan* is really

directed toward the idea of testing programs for correct execution one installed. This is an extremely time consuming process that takes far more time than the expedited installation verification processes taught by the claimed invention. This is especially the case when the hand coding is modified by hand to create specialized test suites as required by *Logan*. Quite simply *Logan* is different from the software installation package verification device and process claimed in the present invention.

Additionally, *Breggin* is offered as teaching verification without executing the installed programs. However, *Breggin* teaches that the installation files must be reviewed and analyzed to generate an "installation database" (*Breggin* 4:17-22) which must then be written to a memory location and then must be compared with certain information and only then can verification results be obtained. So again, this approach requires intermediate steps to establish (generate) an installation database from an installation file. The claimed invention is quicker and more straightforward and does not require any database generation. The claimed invention uses a file list that is a standard part of the installed software package to perform comparisons enabling installation verification. In short, the claimed invention is simpler, quicker, and more efficient than the cited references or any reasonable combination thereof.

Firstly, **Claims 1, 2, 11-13, 15, 20-22, 24, 45, 47, 51, 55, and 60-62** have been cancelled without prejudice. Making this ground of rejection moot as to these claims. As to the remaining claims, the applicants have made amendments believed to distinguish the claimed invention from the cited art. The claims are discussed below.

Claim 44 (and dependent claims 8, 46, 48-50, and 52) has been amended and is believed patentable over the cited art for at least the following reasons. It is argued that the test skeleton of *Logan* is the "control module operable to access the framework to cause the at least one test module identified therein to perform a test comparing the data entries from the file list with information". First, unlike the claimed invention, the test modules of *Logan* do not compare data entries the file list (of the installed software package) in order to verify correct installation. *Logan* requires test cases (i.e., the operation of the installed software) to produce results which should match an expected outcome of the test suite. In other words *Logan* checks to see if certain software components operate properly. *Logan* does not verify that all the appropriate components are present using a file list that forms part of the installed software package. In other words, *Logan* is going to take a lot longer to execute and also is not checking for the same thing as the claimed invention.

Additionally, the web browser (of *Logan*), offered as a control module, is in fact a web browser used to a server to obtain a partition from a server (See, e.g., *Logan* at 4:37-54). It does

not operate to "cause the at least one test module identified therein to perform a test" this browser merely fetches the partition from a remote computer. Moreover, the claimed invention includes the control module, framework, and test modules all on the same computer rather than distributed over a vast network which requires the down loading of the specified test suites each time testing is required.

Additionally, in the present invention is an automated system that does not require hand coding or manual test initiation as does *Logan* (See, e.g., 2:26-28; 6:3-8). Moreover, the testing of *Logan* is directed to three types of tests "background automated tests, interactive automated tests, and automatic checklist processing to support manual testing activities" (*Logan* 8:14-20). The claimed invention does not use background or interactive testing as they are too slow (i.e., requiring test execution of installed programs) and are inefficient for quick installation verification. To the extent the present invention can be said to perform checklist testing, it is done automatically in the present invention (e.g., using a priority driven test execution algorithm). The applicants specifically point out that the test suites of the *Logan* all require execution and operation of the installed program. That is not the case in the claimed invention where the test modules compare certain data already present in a file list that is part of the installed software package.

Breggin is offered as showing test modules that do not require the test execution of the installed software package. However, *Breggin* does not remedy any of the other deficiencies in *Logan* described above. Moreover, *Breggin* does not teach a plurality of interchangeable (e.g., updatable, reconfigurable) priority driven test modules. The tests required of *Breggin* require a first step of generating an installation database that requires parsing a multitude of different files and programs (e.g., the installer program, program files, registry files, etc.) to generate an independent database upon which the testing will operate to determine some installation information. The claimed invention does not work this way. The claimed invention is far simpler, the file list installed with the software package (e.g., in a SOLARIS environment the pkgdir and/or pkginfo files) is directly compared with actual files to determine correct installation. Much simpler, much quicker. Thus, it can not be said that the cited art, alone or in any reasonable combination, teaches all the claim limitations recited in Claim 44. Accordingly, the cited art fails to establish a *prima facie* case of obviousness with respect to Claim 44. Moreover, for at least the same reasons, the cited art has failed to establish a *prima facie* case of obviousness with respect to dependent claims 8, 46, 48-50, and 52. Therefore, it is respectfully requested that the this ground for rejecting Claims 44, 8, 46, 48-50, and 52 be withdrawn.

As to **Claim 14** (and dependent claims 19 and 56-59) the applicants also respectfully traverse the rejection. Claim 14 has been amended and is believed patentable over the cited art for at least the following reasons.

Logan does not teach the “compar[ing] the data entries from the file list with information about an associated software component of the software package to determine correct installation of the software component”. As explained above, the *Logan* test modules do not compare data entries the file list (of the installed software package) in order to verify correct installation. They require the execution of the software to generate test cases to produce test results which should match an expected outcome of the test suite. This is much more involved than the claimed process. The cited art does not verify that all the appropriate components are present using a file list that forms part of the installed software package.

Additionally, *Logan* does not teach the automated operation of the test modules embodied here in the operations of “d) causing ...”, “e) determining ... “f) ... causing another test module to compare ..., then returning to operation e)” and “g) ..., ending the program”. Additionally, as explained above the present invention does not require hand coding or manual test initiation as does *Logan* (See, e.g., 2:26-28; 6:3-8). And again the claimed invention does beyond the three types of tests identified by *Logan*. As before, *Breggin* does not remedy the deficiencies in *Logan*. Moreover the claimed invention does not require the extra step of *Breggin* of generating an “installation database” (e.g., required parsing of the installer program, program files, registry files, etc.) to generate an independent database upon which the testing will operate to determine some installation information. The claimed invention only requires comparison of the file list installed with the software package to conduct comparisons with actual files to determine correct installation. Thus, the cited art, alone or in any reasonable combination, does not teach all the claim limitations recited in Claim 14. Accordingly, the cited art fails to establish a *prima facie* case of obviousness with respect to Claim 14. Moreover, for at least the same reasons, the cited art has failed to establish a *prima facie* case of obviousness with respect to dependent claims 19 and 56-59. Therefore, it is respectfully requested that this ground for rejecting Claims 14, 19 and 56-59 be withdrawn.

As to **Claim 23** (and dependent claims 28 and 63-65) the applicants also respectfully traverse the rejection. Claim 23 has been amended and is in many ways similar to amended Claim 14 and is believed patentable over the cited art for at least the same reasons.

As argued above, *Logan* does not teach the “compare[ing] the data entries from the file list with information about an associated software component of the software package to determine correct installation of the software component”. As explained above, *Logan* requires

the execution of the software to generate test cases to produce test results which should match an expected outcome of the test suite. This is much more involved than the claimed process. The cited art does not verify that all the appropriate components are present using a file list that forms part of the installed software package. Additionally, the *Logan* does not teach the automated operation of the test modules embodied here in the operations of "d) causing ...", "e) determining ... "f) ... causing another test module to compare ..., then returning to operation e)" and "g) ..., ending the program". Also, the present invention does not require hand coding or manual test initiation as does *Logan* (See, e.g., 2:26-28; 6:3-8). Nor does *Breggin* remedy the deficiencies in *Logan*. Additionally, as explained above, the claimed invention avoids the *Breggin* extra step of generating an independent database upon which the testing will operate to determine some installation information. The claimed invention verifies installation using a simple comparison of an existing file list installed with the software package to determine correct installation.

Accordingly, the cited art, alone or in any reasonable combination, does not teach all the claim limitations recited in Claim 23. Accordingly, the cited art fails to establish a *prima facie* case of obviousness with respect to Claim 23. Moreover, for at least the same reasons, the cited art has failed to establish a *prima facie* case of obviousness with respect to dependent claims 28 and 63-65. Therefore, it is respectfully requested that this ground for rejecting Claims 23, 28 and 63-65 be withdrawn.

As to Claim 31, the applicants also respectfully traverse the rejection. Claim 31 has been amended and now includes specific limitations believed patentable over the cited art.

For example, Claim 31 recites "providing a computer having installed thereon a software package ... wherein the software package includes an associated file list, the file list having data entries corresponding to actual contents of the files of the at least one software component" and also a "test module configured to compare selected data entries from the file list with the actual contents of the files of a software component" and conducting such comparison. Again, *Logan* does not teach the comparing data entries from the file list with information about an associated software component to verify installation. The claimed invention does not involve the required execution of the software to generate test cases to produce test results which should match an expected outcome of the test suite as does *Logan*. Nor does *Breggin* remedy the deficiencies in *Logan*. Additionally, *Breggin* requires an extra step of generating an independent database upon which the testing will operate to determine some installation information. Thus, *Breggin* also does not teach comparison of actual file contents with the file list installed on the host computer.

Accordingly, the cited art, does not teach all the claim limitations recited in Claim 31 and therefore fails to establish a *prima facie* case of obviousness with respect to Claim 31. Therefore, it is respectfully requested that the rejection of Claim 31 be withdrawn.

Claim 38 (and dependent claims 39-43) should be allowable for reasons similar to those advanced above. As amended Claim 38 recites limitations of "authenticating the command to verify" and "executing ... verification of the software installation package ... by comparing data from the file list with actual data from installed files of the software component". As explained above, none of these limitations are recited in the cited art. Accordingly, a *prima facie* case of obviousness has not been established with respect to Claim 38. Moreover, for at least the same reasons, the cited art has failed to establish a *prima facie* case of obviousness with respect to dependent claims 39-43. Therefore, it is respectfully requested that the rejection of Claims 38-43 be withdrawn.

It is pointed out that in addition to the reasons for allowance expressed above with respect to the independent claims, most of the dependent claims have independent grounds for allowance. In one such example the rejection of claim 41 is discussed. In the rejection of claim 41 it is asserted that *Logan* (at 11:21-40) teaches the limitation of authenticating a command to verify installation by receiving a verification command and checking that the verification command includes a correct number of arguments. This portion of *Logan* refers to communication between a server and client and does not refer to or otherwise concern confirming a command to verify is correct. Many other arguments could be advanced in support of the various dependent claims, but the sufficiency of the arguments in support of the independent claims makes such discussion unnecessary at this time.

Rejections of Claims 36, 37, 46, and 54 in view of *Logan*, *Breggin*, and *Donahue*:

Claims 36, 37, 46, and 54 stand rejected under 35 U.S.C. §103(a) as being anticipated by the U.S. Patent to *Logan* in view of *Breggin* and further in view of the U.S. Patent to *Donahue* (USPN 6,202,207)(hereinafter *Donohue*).

Claims 36 and 37 have been cancelled, making response to these rejections a moot point. As to Claims 46 and 54, the applicants point out that the combination of *Logan* and *Breggin* are insufficient to reject base claims 44 and 14 and nothing in *Donohue* rectifies these deficiencies. For example, *Donohue* does not teach comparing data entries the file list (of the installed software package) in order to verify correct installation (a deficiency of *Breggin* and *Logan*) nor does *Donohue* teach dispensing with the requirement of generating an installation database (as in *Breggin*). *Donohue* refers to a tool used for locating and importing software updates. Such

teaching is not particularly relevant to installing software packages and insuring that such installation is correct. Accordingly, the motivation to combine such reference with two other references to make the invention obvious is tenuous at best. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). If, as in this case, the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). In the present case, the Office Action has not satisfactorily explained why the suggested combination is proper.

The Office Action, it is stated that "Donohue discloses compatibility with a UNIX based operating system" but offers no rationale supporting a suggestion to combine *Donohue* with the already tenuous combination of *Breggin* and *Logan*. The only significant rational offered for combining the references, states "it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine ... *Logan* with the UNIX based system of *Donohue* ...". This line of reasoning is expressly forbidden by the case law. "The level of skill in the art cannot be relied upon to provide the suggestion to combine references." *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999)(emphasis added). "A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' 'because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.' *Ex parte Levingood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)(emphasis original). There is no suggestion in any of the cited references indicating that they should be combined.

In view of the foregoing, the cited references fail to establish a *prima facie* case of obviousness as to either of Claims 46 or 54. As explained above, there is no suggestion or motivation to modify the reference or to combine reference teachings. Finally, as stated previously, it is not clear that the prior art references teach or suggest all the claim limitations.

Rejections of Claims 3-7, 9, 10, 16-18, 25-27, 29, 30, and 32 in view of *Logan*, *Breggin*, and *Mastronardi*:

Claims 3-7, 9, 10, 16-18, 25-27, 29, 30, and 32 stand rejected under 35 U.S.C. §103(a) as being anticipated by the U.S. Patent to *Logan* in view of *Breggin* and further in view of the U.S. Patent to *Mastronardi* (USPN 6,346,951)(hereinafter *Mastronardi*).

In brief, as to all of the rejected claims, the applicants point out that the combination of *Logan* and *Breggin* are insufficient to reject the base claims upon which all of these rejected claims are based. *Mastronardi* provides no new teaching to rectifies these deficiencies. For example, *Mastronardi* does not teach comparing data entries the file list (of the installed software package) in order to verify correct installation (a deficiency of *Breggin* and *Logan*) nor does *Mastronardi* teach dispensing with the requirement of generating an installation database (as in *Breggin*).

In order to reject Claims 3-7, 9, 10, 16-18, 25-27, 29, 30, and 32 another reference (*Mastronardi*) is required to assert that the claimed invention is "obvious". *Mastronardi* is deficient as a reference for several additional reasons. First, *Mastronardi*'s definition of "active" is different from 'active' as it is used and defined in the present invention. Active in the *Mastronardi* invention means that a given task is operating right now (that is what the *Mastronardi* "test" does, it tests to determine whether the "task" is "active"). In the claimed invention, the control module determines whether the 'tests' will be used in a selected test sequence. If the 'tests' are to be used in the test sequence, then they are 'active'. If the 'tests' are not to be used, then they are inactive. Moreover, in *Mastronardi*, the "test" is the thing that determines whether the process is "active". In the claimed invention the 'test' is something that will be performed (if the 'test' is 'active') on the software installation package to verify the package. Thus, we are talking apples and oranges. Although *Mastronardi* uses the same words, the words have a different meaning, context, and application. Thus, *Mastronardi* has nothing whatsoever to do with the present invention. Accordingly, *Mastronardi* does nothing to correct the hightlighted deficiencies of the *Logan* and *Donohue* references with respect to Claims 3-7, 9, 10, 16-18, 25-27, 29, 30, 32, 34, and 35. Therefore, it is respectfully requested that the this ground for rejecting Claims 3-7, 9, 10, 16-18, 25-27, 29, 30, 32, 34, and 35 be withdrawn.

Rejections of Claims 34 and 35 in view of *Logan*, *Breggin*, *Peter*, and *Mastronardi*:

Claims 34 and 35 stand rejected under 35 U.S.C. §103(a) as being anticipated by the U.S. Patent to *Logan* in view of *Breggin* and further in view of the U.S. Patent to *Peter et al* (USPN 6,418,389)(hereinafter *Peter*) and still further in view of *Mastronardi*.

In brief, as to both of the rejected claims, the applicants point out that the combination of *Logan* and *Breggin* are insufficient to reject the base claim 33 (as discussed above). *Mastronardi* provides no new teaching to rectify the shortcoming of the "base references". For example, *Mastronardi* does not teach comparing data entries the file list (of the installed software package) in order to verify correct installation (a deficiency of *Breggin* and *Logan*) nor does *Mastronardi* teach dispensing with the requirement of generating an installation database (as in *Breggin*). Additionally, *Mastronardi* does not teach active not active as those terms are used in the Specification so is additionally defective. Moreover, a strong argument is presented asserting that there is no motivation to combine the above references. The same shortcomings apply to *Peter* which does not address the outstanding unaddressed limitations. Moreover, there is probably no motivation to combine the four asserted references. The applicant's point out that just because references can be combined is not enough render the resultant combination to be obvious (MPEP 2143, e.g., *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). Moreover, just because something is within the capabilities of one with ordinary skill in the art is not sufficient to establish a *prima facie* of obviousness.

The above-mentioned four references are lacking in a motivation to combine. In order to reject **Claims 34 and 35** these four references are required to assert that the claimed invention is "obvious". "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). If, as in this case, the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). In the present case, the Office Action offers that it would have been obvious to one of ordinary skill to combine. This is not sufficient, in fact, this line of reasoning is expressly forbidden by the case law. "The level of skill in the art cannot be relied upon to provide the suggestion to combine references." *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999)(emphasis added). "A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to

combine the teachings of the references." *Ex parte Levingood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)(emphasis original). Here, there is no objective reason to combine nor is there a suggestion in any of the cited references indicating that they should be combined.

In view of the foregoing, the cited references fail to establish a prima facie case of obviousness as to either of Claims 34 or 35. As explained above, there is no suggestion or motivation to modify the reference or to combine reference teachings. Finally, as stated previously, it is not clear that the prior art references teach or suggest all the claim limitations.

Therefore, it is respectfully requested that the this ground for rejecting Claims 34 and 35 be withdrawn.

CONCLUSION

Applicants respectfully submit that based on the amendments and remarks made herein that all pending claims (Claims 3-10, 14-19, 23, 25-35, 38-44, 46, 48-50, 52, 54, 55, 56-59, and 63-65) are in condition for allowance and therefore respectfully request a Notice of Allowance for this application from the Examiner. The Examiner is cordially invited to contact the applicants' attorney to discuss any matters concerning this case. If the Examiner wishes to contact the applicant's attorney by telephone he can be contacted at any of the telephone numbers set forth below.

Respectfully submitted,
BEYER WEAVER & THOMAS, LLP


Francis T. Kalinski II
Registration No. 44,177

P.O. Box 70250
Oakland, CA 94612-0250
Telephone: (650) 961-8300

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